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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,612	03/05/2002	Per A. Tagseth	40655.4300	8241
66170 7590 05/06/2010 Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER				
AHMED, AFFAF				
ART UNIT		PAPER NUMBER		
3622				
NOTIFICATION DATE		DELIVERY MODE		
05/06/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/091,612

**Applicant(s)**

TAGSETH ET AL.

**Examiner**

AFAF AHMED

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 51-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17 (e), was filed in this application after final rejection. since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17 (e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/04/2010 has been entered.
2. Claims 1-50 have been canceled.
3. Claims 51-70 are currently pending and have been examined.

### ***Response to Applicant's Arguments***

4. Applicant's amendments and arguments filed on 03/04/2010 have been fully considered and discussed in the next section. Applicant is reminded that the claims must be given its broadest, reasonable interpretation.
5. With regard to claims 1-5, 9-36 rejection under 35 U.S.C. § 101, Applicant has canceled the claims. Therefore, the claim rejection of claims 1-5, 9-36 rejection under 35 U.S.C. § 101 is withdrawn.
6. With regard to claims 51, 69 and 70 :
  - Applicant argues that *"the cited reference alone or in combination do not discloses or contemplate at least analyzing a plurality of prior transactions from a user transaction account, wherein the plurality of prior transactions are associated with user purchases of at least one of goods or services from a merchant" or customizing an incentive offer from a centralized repository based at least portion on the user formulated search and at least a portion of the plurality of prior transactions."*

Examiner respectfully disagrees. Brody in at least paragraph 14 discloses a method and system for selecting a plurality of pre-approved offers for the consumer based at least partially on the credit history data (prior purchase of user's transactions that are associated with purchases of at least one good or services from a merchant) of the consumer and a subject preference provided by the consumer. Brody also in at least paragraph 41 discloses an embodiment, where the offer processing engine identifies and retrieves the identity of consumers who are seeking a subcategory of loans via a selectable graphic interface. Furthermore, Brody, in at least paragraph 54 discloses an embodiment, where information received from the consumer may be extensive and exhaustive so that the consumer can be accurately identified and offered customized service based upon one or more aspects of the consumer's profile.

### ***Claim Rejections - 35 USC § 112***

7. Claims 1, 66, 69 and 70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. Claims 1, 69 and 70 recite the limitation of:

9. analyzing, by the computer-based system, a plurality of prior transactions from a user transaction account, wherein the plurality of prior transactions are associated with user purchases of at least one of goods or services from a merchant. The specification teaches "presentation engine facilitates the configuring of offers based on the traits of offerees and the contexts in which the offer is to be presented to the offerees. For example, if a particular offeree has demonstrated a certain level of creditworthiness, the presentation engine may configure an offer for a credit card to have a lowered interest rate in accordance with a set of rules accompanying the offer details (paragraph 25). the specification does not teach "analyzing, a plurality of prior transactions from a user transaction account, wherein the plurality of prior transactions are associated with user purchases of at least one of goods or services from a merchant.

10. Claim 66 recites the limitation of: wherein the centralized repository is a closed system, searchable only by the user having the user transaction account. The specification teaches "search is performed dynamically based on one or more variables that may be defined 140 by the user 150.

These online offers can be accessed by anyone with access to the database, including internal functions or those hosted by external third parties (paragraph 34).” the specification does not teach wherein the centralized repository is a closed system, searchable only by the user having the user transaction account.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 51, 52, 58, 68 and 69 are rejected under 35 U.S.C. 112, second paragraph. There is insufficient antecedent basis for the above limitations. Appropriate correction and/ or clarification is required. Applicant is advised to revise the above claims for insufficient antecedent basis. Here are some examples.

13.

14. Claims 51 and 69 recite the limitations of :

- customizing the incentive offer from a centralized repository of incentive offers,
- displaying, by the computer-based system, the incentive offer to the user

### ***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 51, 69 and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by Brody et al, US Pub No: 2002/0077964 A1

As per **claims 51, 69 and 70**, Brody teaches:

- *receiving a user formulated search by a computer system for customizing an incentive offer (see at least paragraph 41);*
- *analyzing, by the computer-based system, a plurality of prior transactions from a user transaction account, wherein the plurality of prior transactions are*

*associated with user purchases of at least one of goods or services from a merchant (see at least paragraphs 7, 14 and the abstract);*

- *customizing, by the computer-based system, the incentive offer from a centralized repository of incentive offers, based on at least a portion of the user formulated search and at least a portion of the plurality of prior transaction (see at least paragraphs 14, 41, 54 and fig 2 with the associated text); and*
- *displaying, by the computer-based system, the incentive offer to the user (see at least paragraph 75);*

As per **claim 52**, Brody teaches:

- *maintaining, by the computer-based system, the incentive offers, wherein the incentive offers are at least one of created, modified, or deleted within the centralized repository in response to an administrator request (see at least paragraphs 44 and 47);*

As per **claim 53 and 54**, Brody teaches:

- *authenticating, by the computer-based system, the merchant in response to a request by the merchant to submit an incentive offer to the centralized repository;*
- *limiting access to the merchant to the centralized repository;*

See at least paragraphs 33 and 72;

As per **claim 55**, Brody teaches:

- *tracking, by the computer-based system, a number of times the incentive offer has been displayed to the user (see at least paragraph 44);*

As per **claim 56**, Brody teaches:

- *tracking, by the computer-based system, a number of times a class of the incentive offers has been displayed to the user (paragraph (see at least paragraphs 44 and 69-70);*

As per **claim 57**, Brody teaches:

- *wherein the incentive offer is displayed via a webpage (see at least paragraph 55 and 69);*

As per **claims 58 and 59**, Brody teaches:

- *generating, by the computer-based system, a report describing the incentive offers contained within the centralized repository.*
- *wherein the report describes a number of times the incentive offer has been retrieved;*

See at least paragraph 44 and fig 2 with the associated text;

As per **claim 61**, Brody teaches:

- *wherein the offer details include at least of an offer identifier, an offer promotion identifier, an offer type, or a definition of offer terms (see at least paragraph 69);*

As per **claim 62**, Brody teaches:

- *wherein the offer further identifying at least one of a merchant name, a target merchant, a target good, or a target service (see at least paragraphs 54 and 68);*

As per **claim 63**, Brody teaches:

- *wherein the offer further includes at least one of merchant demographic, merchant type, or geographic location identifier (see at least paragraphs 52 and 78);*

As per **claim 64**, Brody teaches:

- *wherein the offer further includes at least one of offer category identifier, a target product, or service identifier (see at least paragraph 68);*

As per **claim 65**, Brody teaches:

- *wherein the offer further includes at least one of a description of terms of the offer, a term length for displaying the offer, a keyword, SKU/UPC information, or customer service telephone number (see at least paragraph 41);*

As per **claim 66**, Brody teaches:

- *wherein the centralized repository is a closed system, searchable only by the user having the user transaction account (see at least paragraph 33);*

As per **claim 67**, Brody teaches:

- *wherein the centralized repository is maintained by an issuer of the user transaction account (see at least paragraphs 41, 44 and fig 2 with the associated text);*

As per **claim 68**, Brody teaches:

- *receiving, by the computer-based system, an acceptance of the incentive offer from the user (see at least paragraphs 16 and 42);*

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brody, US Pub No: 2002/0077964 A1 in view of Cunningham, US Pat 6,014,645.

Claim 60:

Brody discloses the limitations as shown above.

Brody does not specifically disclose, but Cunningham however discloses:

- *modifying, by the computer-based system, the incentive offer in accordance with a predetermined set of rules (see at least column 4, lines 16-64);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to include Brody's pre-approved financial offers method and system, the ability to modifying financial offers in real time as taught by Cunningham, since the claimed invention is a combination of old elements, since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of (providing users personalized offers that meet consumers' need)) were predictable.



***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/  
Primary Examiner, Art Unit 3622